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OFFICE OF PETITIONS

In re Application of
Thomson, et al.
Application No. 10/813,640
Filed: 29 March, 2004
Attorney Docket No.: THMC:015US/MTG

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: DECISION ON PETITION
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This is a decision on the renewed petition under 37 C.F.R. §1.10(d)), filed on 18 February, 2005, and seeking for the above-identified application a filing date of 29 March, 2004, instead of the presently accorded filing date of 30 March, 2004.

The petition is **GRANTED**.

BACKGROUND AND ANALYSIS

The starting point of the discussion is the controlling law, *i.e.*, the regulations at 37 C.F.R. §1.10(d) provide in pertinent part:

* * *

(d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

* * *

(3) The petition includes a showing which

establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS. (Emphasis supplied.)¹

* * *

The record reflects that:

- while the instant application was received and given by the Office a filing date of 30 March, 2004, after the US Postal Service (USPS) assigned that date as the date of its acceptance of the package bearing USPS Express Mail Label No. EV414834354US, the original petition contended that the instant application submitted with that USPS Express Mail Label Number was one of but four applications filed contemporaneously at a USPS Express Mail drop box in Austin, Texas, at about 6:55 p.m. before a 7:00 p.m. scheduled pick-up on Monday, 29 March, 2004, however, the instant application and one other

¹ The regulations at 37 C.F.R. § 1.10 provide, in pertinent part:

§ 1.10 Filing of papers and fees by "Express Mail."

(a) Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date. See § 1.6(a).

* * *

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

* * *

(d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

* * *

(f) The Office may require additional evidence to determine if the correspondence was deposited as "Express Mail" with the USPS on the date in question. (Emphasis supplied.) [48 Fed. Reg. 2708, Jan. 20, 1983, added effective Feb. 27, 1983; 48 Fed. Reg. 4285, Jan. 31, 1983, paras. (a) & (c), 49 Fed. Reg. 552, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a)-(c) revised and paras. (d) - (f) added, 61 Fed. Reg. 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (d) & (e) revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

received a 30 March, 2004, filing date while the remaining two applications received the desired 29 March, 2004 filing date;

- the original petition was dismissed because Petitioner's showing was insufficient under 37 C.F.R. §1.10(d);
- the instant renewed petition recites that attachments/enclosures (including, *inter alia*, copies of the Transmittal Cover Sheet, the return post card, USPS Express Mail Label No. EV414834354US and declarations from Petitioner and two co-workers and copies of certain personal and office documents) evidence that the documents are such as are required under 37 C.F.R. §1.10(d) "that came into being after deposit and within one business day of the deposit of the correspondence in the 'Express Mail Post Office to Addressee'" to evidence the timely 29 March, 2004, deposit of the Express Mail package containing the instant application prior to the last scheduled pick-up of the day;
- in lieu of a mail log or other such office records, Petitioner particularly points to:
 - a client transmittal letter prepared by Ms. Julie Hohle (Ms. Hohle) consistent with her practice (with application docket number, invention title, and name of the first named inventor), which—though not dated and mailed until 1 April, 2004—was created and prepared, Ms. Hohle and Petitioner assert, within one (1) business day, and Petitioner and Ms. Hohle point to a copy of that letter with a document code number at the bottom left corner of the base, which number correlates with that on a "screen shot" of document-management system of Petitioner's office and demonstrates that the transmittal letter was created on 30 March, 2004, the day after Petitioner alleges timely deposit of the instant application into the USPS mailbox; and
 - a client billing document (also with application docket number, invention title (partial), and name of the first named inventor), which was created and prepared, Petitioner asserts, after deposit of the application with the USPS and within one (1) business day thereof;
- Petitioner further points to the declarations of Ms. Hohle and Ms. Sherry Stowers (Ms. Stowers) confirming that Ms. Hohle assisted in preparation of this application (and Ms. Stowers the international companion to it) as well as two other applications with which Petitioner left his office the early evening of 29 March, 2004, *en route* to the USPS post office to deposit the instant application (and others), and:
 - Ms. Stowers saw and spoke with Petitioner after he returned to

their office that evening and confirmed with him that he had accomplished the filing (i.e., deposit of the applications timely into the USPS mailbox before the last scheduled pick-up at 7:00 p.m. that evening), and

–Ms. Hohle confirmed with Petitioner the next morning, 30 March, 2004, that the filing (deposit) had occurred timely and, consistent with her office practice, prepared the client transmittal letter, which was then dated and mailed to the client on 1 April, 2004, along with a copy of the application;

- Petitioner also submits personal telephone and work-log entries, however, these are of limited benefit at best due to their abbreviated and/or undefined nature.

Clearly, Petitioner's satisfaction of the burden of proof in this matter has been made much more difficult by the lack of a mail log—particularly an Express Mail log—prepared after the deposit of the application in the USPS, the use of the mailbox rather than directly depositing the application with a USPS employee (see: 37 C.F.R. §1.10(b)) and/or another recording procedure providing an interlocking chain of evidence containing the USPS Express Mail number. Moreover, a practice of searching for (as well as obtaining and retaining for Petitioner's file) a printout/copy of the Track & Confirm data from the USPS website within a day (or two) of deposit can alert Petitioner that a problem may exist with the USPS assignment of an acceptance date of the Express Mail parcel—and, thus, with the filing date to be assigned to the application by the Office.

Nonetheless, Petitioner has made a sufficient showing herein.

Accordingly, the petition hereby is **granted**.

The petition fee is not waived because the error was not that of the Office, and was charged as authorized.

The instant file is released to OIPE to correct the filing date so as to accord to the instant application a filing date of 29 March, 2004, and to mail to Petitioner a corrected filing receipt reflecting a filing date of 29 March, 2004.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



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